



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,446	11/14/2003	Kenneth A. Walker JR.	03-025	9623

37420 7590 05/09/2005

VISTA PRINT USA INC.
100 HAYDEN AVENUE
LEXINGTON, MA 02421

EXAMINER

WOODS, ERIC V

ART UNIT	PAPER NUMBER
----------	--------------

2672

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,446

Applicant(s)

WALKER ET AL.

Examiner

Eric V Woods

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20050309</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The specification is objected to because it refers to an element not shown in the drawings. See the drawings objection below, the element in question is labeled as 150, as listed on line 3 of page 5 of the specification of the instant application.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 1 does not contain input devices 150.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because Figure 1 contains an element not defined in the specification – Input 130.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roses (US PGPub 2003/0055871 A1) in view of Noda et al (US PGPub 2002/0030634). Claim 11 is directed to a system implementing the method of claim 1, and the means-plus-function limitations are discussed below. Any dependent claims that have means plus functional language are covered by the rejection of such components in the rejection immediately below, so such language will not be explicitly addressed. Further, any rejections valid on claims 1-10 are equally valid on the corresponding claims of set 11-20.

6. As to claims 1 and 11, a computer-implemented method for facilitating user customization of the image content of an image area in an electronic product design, the method comprising: (Roses [0068] stating the method is computer-implemented, Fig. 1 clearly shows a document composition website 110 that is connected to a customer photo web site 115 and general web site 120 for obtaining photos and images for obtaining image content for insertion into a document (see Fig. 2, where the images are put into an image basket) and such documents and their templates are shown in Fig. 5, with an image editing step shown in Fig. 6 with cropping capabilities as shown

and in [0037,0043,0048], and Noda clearly allows the user to manipulate the image area for cropping as shown in Fig. 2 with the boundaries and crop frame 84)

-Displaying an electronic product design to a user, the design containing at least one or more image areas, each image area having a known height and width; (Roses shows an electronic document or product design in Fig. 5, with the image areas shown in Fig. 6 and allowing the user to manipulate them – see [0028] for posters, Fig. 10 shows as item 1021 and next to it, that a “Year 2001 Calendar Type” can be chosen as a template, thus illustrating another type of document template, the document creation module / tool of Roses is shown in Fig. 2 as element 206, which is facilitated by the document creation / storage module 306 in Fig. 3 – see [0032-0033], where Roses teaches that documents have areas for fixed images (e.g. images with a fixed size, thus requiring cropping as in Fig. 6). Further, in [0047], it is taught that templates can have modifiable images, e.g. images that can be modified by the user, wherein the fixed images consist of images of a given size for insertion into a block, where in [0048] it is taught that the fixed images are clearly modifiable, since they can be cropped, filter, moved (location), et cetera) (User selects the image as input in Noda [0052], and further Noda allows the user to select the inner area where the image will be inserted from a template [0002,0024], and in Figs. 9A-9F where various layouts of photos for albums, etc. are shown. Further, these areas have fixed height and width in [0077-0078], as is known in the art (e.g. L-size, etc.))

-Allowing the user to select an image area for customization, and (Roses [0047-0048] wherein there are modifiable images in the template that the user can customize, and

also the fixed images can be customized by allowing the user to choose the image)(User selects the image as input in Noda [0052], and further Noda allows the user to select the inner area where the image will be inserted from a template [0002,0024], and in Figs. 9A-9F where various layouts of photos for albums, etc. are shown, and finally in [0042-0043] it is taught that the user can select and customize the placement of text and images in modifiable areas)

-After user selection of an image area, displaying to the user an image, and (Roses Fig. 6 and [0043-0044], where the image is displayed in the section 611 for example, and the user can preview the document so in area 602 whilst editing it here)(Noda Fig. 3 where the image is displayed in area 46, and the user selects which image to show [0052] in the full size)

-A cropping indicator having the same ratio of height to width as the selected image area. (Cropping indicator 84 in Noda Fig. 3 as discussed in [0081] is fit to the selected paper size or template spot, thusly inherently have the same height to width ratio as the selected image area, since it matches that of the template, e.g. further in [0081] it teaches that a crop boundary specific to the selected paper size or the template is displayed, which clearly meets the last limitation of the claim.)

Applicant invokes means-plus-function language in claim 11. Clearly, the recited means would be equivalent to that of applicant. For example, the customization capabilities of the Roses reference in Figs. 4-7 and as taught in [0042-0043], where templates can be edited and have specific areas and layouts, as does Noda, for example in Figs. 9A-9F, and even more so in Figs. 10A-10D where the user can

Art Unit: 2672

configure the locations of the various regions that are superimposed, which clearly provides the functionality recited by applicant in the specification and shown in for example Fig. 3. In Fig. 4 of the instant application, where the user can change cropping of an image, the user clearly can make those choices as shown in Fig. 6 of Roses and Figs. 3-5 and 11-13 of Noda, and the user can switch between images as shown with the navigation buttons on the Roses reference in Fig. 3 in the image chooser box, and Noda also allows modification in that manner. Clearly the image modification system of applicant shown in Figs. 5-9 of the instant application corresponds to the system of Noda in Fig. 3, with the manipulable cropping areas and boundaries (see element 84) and further in [0081-0084] Noda reveals that the crop boundary may be changed in size so as to correspond to the capabilities of applicant's recited invention. Clearly, both systems are software, and it is well known in the art that any piece of software functionality can easily be implemented on another (same look and feel) in a manner where the functionality is alike yet uses completely different code to do so. As such, the means plus function limitations under 35 U.S.C. 112, sixth paragraph, have been met, and examiner has met the burden to prove a *prima facie* case of equivalence between the recited elements. It is now applicant's responsibility to rebut the premise that applicant's invention and the equivalent functions of Roses and Noda are the same if applicant wishes to do so.

Roses teaches all the limitations of the stated claims, but does not expressly provide for the cropping indicator having the same height-to-width ratio as the selected image area, although since the image can be cropped such that it fits in the template,

this is implied. Reference Noda also teaches most of the limitations, and explicitly teaches the use of customizable images and templates, and a manipulable cropping tool. Obviously the references are directed to a similar problem solving area and are analogous art, as both deal with inserting images into document templates and manipulating them.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system of Roses with that of Noda because the system of Noda clearly allows for more effective cropping of images to fit in templates as set forth in the paragraphs above, especially since Roses does not show how the images are cropped per se or if the user is able to expressly choose the desired portion of an image to go in the template, and further Noda allows more options as far as customizing images such that when the image customization process is complete, multiple images could be combined into one and put into the documents of Roses (Figs. 4-6) or Noda (Figs. 10A-10D), which would prima facie allow for greater flexibility in how the user can manipulate the documents, as shown in Noda, which is beneficial.

7. As to claims 2 and 12, clearly as explained above, the cropping boundary of Noda – element 84 in Fig. 3 – clearly corresponds to the portion of the image that would be cropped and placed within the selected image area [0081-0082]. Motivation and combination is taken from the parent claim and incorporated by reference herein.

8. As to claims 3 and 13, as set forth in the rejection to claim 1, Noda allows the user to change the size, position, and other aspects of the cropping boundary, which is

prima facie equivalent to the cropping indicator [0083-0084]. Motivation and combination is taken from the parent claim and incorporated by reference herein.

9. As to claims 4 and 14, Noda clearly sets forth in [0082-0083] that the user cannot change the aspect ratio (e.g. the width to height ratio) even though the size can be in certain embodiments. Motivation and combination is taken from the parent claim and incorporated by reference herein.

10. As to claims 5 and 15, the system of Roses allows the user to view the image in the preview window 602 of Fig. 6 when the image has been selected and scaled and/or cropped to fit, or manually filtered – see Fig. 6 and [0043-0044], and so it is updated, and the user can also do so at any time by hitting the preview button. Since only the primary reference is utilized, no separate motivation or combination is required and that from the rejection to the parent claim is herein incorporated by reference. Updating an image upon modification in the preview window is also prima facie obvious.

11. As to claims 6 and 16, the user can prima facie move the crop boundary / indicator around the image in Noda as taught in [0081] and as shown in Fig. 3 for example. Motivation and combination is taken from the parent claim and incorporated by reference herein.

12. As to claims 7 and 17, the system of Roses allows the user to view the image in the preview window 602 of Fig. 6 when the image has been selected and scaled and/or cropped to fit, or manually filtered, or the cropping window has been repositioned or moved (see Noda [0081—0082]) – see Fig. 6 and [0043-0044], and so it is updated, and the user can also do so at any time by hitting the preview button. Updating an

image upon modification in the preview window is also prima facie obvious. Motivation and combination is taken from the parent claim and incorporated by reference herein.

13. As to claims 8 and 18, this is a prima facie obvious limitation, wherein the image will contain the selected area, given that in some embodiments, as in Noda and as stated in the rejection to claims 5 and 15 above, the user cannot change the aspect ratio of the area to be cropped. Further, the system of Roses clearly does not allow the user to put more of an image in an area than is allowed, e.g. at the end of [0043] Roses clearly states that a warning will be displayed to the user if the image does not fit, such that the user must modify the image such that it does fit using the cropping tools, by showing a warning in warning area 614 in Fig. 6. Motivation and combination is taken from the parent claim and incorporated by reference herein.

14. As to claims 9 and 19, clearly Roses allows the user to choose from a variety of images that are in the image basket, by switching between them using the Prev and Next buttons 609 as shown in Fig. 6, and further as shown in Fig. 3, the user can put images in an image basket so that multiple images are available to the user [0028-0029, etc.]. Clearly Noda allows the user to select multiple images, since the picture options in Figs. 10A-10D clearly prima facie require multiple images to be superimposed upon each other, where in [0009] it is stated that the user can select the images from amongst a plurality. Motivation and combination is taken from the parent claim and incorporated by reference herein.

15. As to claims 10 and 20, clearly a default crop area will be generated in Noda [0081-0086] when the image is displayed on the screen to cropped because it will prima

facie be associated with an image area having a known height and width, as recited in the parent claim, and once the user selects the image to be associated with the image area using area 610 of Roses, clearly, the system of Noda will allow the user to manipulate it if required and desired, and such an image will automatically pop the cropping boundary into the position shown as in Fig. 3 of Noda. Motivation and combination is taken from the parent claim and incorporated by reference herein.

Conclusion

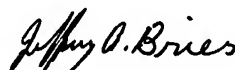
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric V Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-4:30 alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on 571-272-7664. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric Woods



JEFFREY D. BRIES
PRIMARY EXAMINER

April 28, 2005